

### REMARKS

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

#### Paragraph 1 of the Office Action

Claim 13 has been objected to for the informalities noted in the Office Action.

Claim 13 has been amended in a manner believed to clarify any informalities in the language.

Withdrawal of the objection to claim 13 is therefore respectfully requested.

#### Paragraphs 2 through 5 of the Office Action

Claims 1 through 3 and 15 through 18 have been rejected under 35 U.S.C. §102(b) as being anticipated by Aragona for substantially the same reasons stated in the first Office Action.

Claims 4 through 7 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Aragona as applied to claim 1 above, and further in view of Yasui for substantially the same reasons stated in the first Office Action.

Claims 1 through 7 and 15 through 18 have been cancelled, and therefore the §102(b) and §103(a) rejections of claims 1 through 7 and 15 through 18 are submitted to be moot.

#### Paragraph 6 of the Office Action

Claims 8 through 14 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Aragona as applied to claim 1 above, and further in view of Shepherd.

The rejection of the Office Action relies upon a combination of the Aragona and Shepherd patents in attempting to assemble the combination of elements required by applicant's claims 8 through 14.

It is significant to note that the courts have recognized that most elements of inventions can be found somewhere in the prior art.

Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

*In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

And thus the ability to find each one of the claimed elements in the prior art does not in and of itself negate patentability.

Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

*In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

The Office Action sets forth a number of reasons that are alleged to support the combinations of the various parts of the cited references. However, these reasons do not appear to be taken from the prior art, but from an ex post facto analysis of the combination of the features disclosed in the applicant's application, and possible benefits of the applicant's invention applied to the prior art parts.

In particular, the Office Action alleges that "it would have been obvious to locate the vibration assembly of Aragona within the fishing pole as shown by Shepherd to make the unit compact". However, Aragona clearly teaches as a number of purposes and objects that require that the oscillating driving assembly be positioned outside the fishing rod. For

example, Aragona discloses in col. 1, line 66 through col. 2, line 3 (emphasis added), that:

Still other features would be desirable in a fishing rod jigging apparatus. For example, it would be desirable if the major components of a fishing rod jigging apparatus were arrayed on a base so that a relatively low center of gravity is obtained.

Further, Aragona discloses at col. 2, lines 3 through 5 (emphasis added), that:

It would also be desirable for a fishing rod jigging apparatus to permit a conventional fishing rod and reel to be readily removed from and placed in the apparatus

Still further Aragona teaches at col. 2, lines 21 through 31 (emphasis added), that:

a fishing rod jigging apparatus which has the following combination of desirable features: (1) has a relatively low center of gravity; (2) permits the use of a conventional fishing rod and reel; (3) does not include complex electronic circuitry; (4) does not include springs for providing a jigging motion; (5) does not include cams for imparting a jigging motion; (6) arrays major components of a fishing rod jigging apparatus on a base in such a way that a relatively low center of gravity is obtained; and (7) permits a conventional fishing rod and reel to be readily removed from and placed in the apparatus.

Therefore it is submitted that one of ordinary skill in the art, considering the disclosure of Aragona, would not be motivated to move the oscillating driving assembly into the fishing rod, as this would prevent the use of a conventional fishing rod and reel (and thus require a specialized rod), and would prevent the removal of the rod and reel from the apparatus. Further, it is noted that the Shepherd reference is silent as to any suggestion that the incorporation of an oscillating driving assembly in the fishing rod is desirable as it is more compact than the Aragona arrangement.

Therefore, it is submitted that, if the objects of the primary reference would have to be abandoned to attempt to make the allegedly obvious modification, and secondary reference does not provide any

motivation to modify the primary reference by adopting the structure of the secondary reference, the modification of the primary reference structure with the secondary reference structure is not prima facie obvious.

A motivation must be provided by the prior art to make the allegedly obvious combinations of parts relied upon in making an obviousness rejection.

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998).

In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Absent a showing of motivation in the prior art to make the allegedly obvious combination, it can only be assumed that the applicant's disclosure has provided the motivation for making the combination of elements from the prior art, and not the prior art itself.

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is therefore submitted that the combination of individual parts taught by the various prior art references relied upon in the Office Action would not motivate one skilled in the art to arrive at the applicant's claimed invention.

Withdrawal of the §103(a) rejection of claims 8 through 14 is therefore respectfully requested.

**Paragraph 7 of the Office Action**

Claim 19 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Aragona as applied to claim 1 above, and further in view of Daniels for substantially the same reasons stated in the first Office Action.

Claim 19 has been cancelled, and therefore the §103(a) rejection of claim 19 is submitted to be moot.

**Paragraph 8 of the Office Action**

Claim 20 has been allowed.

**VERSION WITH MARKINGS TO SHOW CHANGES MADE:**

**In the Claims** (bracketed parts deleted and underlined parts added):

Cancel claims 1 through 7.

1           8.     (Pending) The fish luring system of claim 1, wherein  
2 said vibrating assembly includes:  
3           a motor adapted for rotational movement, said motor being  
4 mounted in an interior of said handle portion;  
5           a motor shaft being rotatably coupled to and extending from  
6 said motor toward a first end of said rod portion, said motor shaft  
7 being positioned in a channel extending longitudinally in said rod  
8 portion;  
9           a cam being formed on an end of said motor shaft for  
10 selectively engaging an inner surface of said channel of said rod  
11 portion, wherein rotational movement of said motor shaft by said  
12 motor causes said cam to selectively engage said inner surface and  
13 vibrate said first end of said rod portion; and  
14           wherein said vibrating assembly is positioned within said  
15 fishing pole.

1           9.     (Pending) The fish luring system of claim 8, wherein  
2 said end of said motor shaft mounted on said cam being positioned  
3 generally adjacent to a central portion of said cam such that said  
4 cam travels in an eccentric circle when rotated by said motor shaft,  
5 wherein said cam causes said first end of said rod portion to vibrate,  
6 wherein vibration of said first end of said rod portion vibrates the  
7 fishing line and an attached lure.

1           10.    (Pending) The fish luring system of claim 8, additionally  
2 including a power supply for selectively providing power to said  
3 motor, said power supply being mounted in said interior of said

4 handle portion, a cap for covering an open end of said handle  
5 portion.

1 11. (Pending) The fish luring system of claim 10,  
2 additionally including a biasing member for selectively biasing said  
3 power supply away from an interior of said cap, said biasing  
4 member being attached to a bottom surface of said cap and  
5 positioned generally between said cap and said power supply.

1 12. (Pending) The fish luring system of claim 8, additionally  
2 including a switch for selectively controlling said motor, said  
3 switch being depressibly mounted on a protruding portion extending  
4 away from said handle portion, said switch being electrically  
5 connected to said motor.

1 13. (Amended) The fish luring system of claim 1, wherein  
2 said vibrating assembly includes:  
3 a vibrating means adapted for vibrating said fishing pole, said  
4 vibrating means being mounted in an interior of said handle portion  
5 of said fishing pole[;]

1 14. (Pending) The fish luring system of claim 13,  
2 additionally including a power supply for selectively providing  
3 power to said vibrating means, said power supply being mounted in  
4 said interior of said handle portion.

Cancel claims 15 through 19.

1 20. (Allowed) A fish luring system for luring fish to a lure  
2 attached to an end of a fishing line, said system comprising:  
3 a fishing pole having a rod portion and a handle portion, said  
4 rod portion having a first end and a second end, said second end of

5 said rod portion having a channel extending into said rod portion,  
6 said channel extending along a longitudinal axis of said rod portion;  
7 said handle portion being mounted on said second end of said  
8 rod portion, said handle portion having an interior with an open end  
9 extending into said interior of said handle portion;  
10 said interior of said handle being in communication with said  
11 channel extending through said rod portion of said fishing pole;  
12 a protruding member for selectively supporting a finger of a  
13 user, said protruding member extending away from a peripheral wall  
14 of said handle portion;  
15 said protruding member having a width tapering from said  
16 handle portion toward an end of said protruding member;  
17 a cap for selectively closing said open end of said handle  
18 portion, said cap having an inner surface;  
19 said inner surface of said cap being threadedly coupled to an  
20 outer surface of said handle portion adjacent to said open end of  
21 said handle portion;  
22 a plurality of eyelets being mounted on said rod portion, each  
23 of said eyelets being spaced apart from each other, each of said  
24 eyelet being in registration with each of the other;  
25 a vibrating assembly for vibrating said fishing pole, said  
26 vibrating assembly including:  
27 a motor adapted for rotational movement, said motor being  
28 mounted in said interior of said handle portion;  
29 a motor shaft being rotatably coupled to and extending from  
30 said motor toward said first end of said rod portion, said motor  
31 shaft being elongated and positioned in said channel in said rod  
32 portion;  
33 said motor shaft comprising a substantially rigid material;



34 a cam being formed on an end of said motor shaft for  
35 selectively engaging an inner surface of said channel of said rod  
36 portion of said fishing pole;  
37 said end of said motor shaft mounted on said cam being  
38 positioned generally adjacent to a central portion of said cam such  
39 that said cam travels in an eccentric circle when rotated by said  
40 motor shaft, wherein said cam selectively engages said inner surface  
41 of said channel in said rod portion of said fishing rod, wherein said  
42 cam causes said first end of said rod portion to vibrate, wherein  
43 vibration of said first end of said rod portion vibrates the fishing  
44 line and an attached lure;  
45 said cam comprising a substantially rigid material;  
46 a power supply for selectively providing power to said motor,  
47 said power supply being mounted in said interior of said handle  
48 portion, said power supply being electrically connected to said  
49 motor;  
50 a biasing member for selectively biasing said power supply  
51 away from an interior of said cap, said biasing member being  
52 attached to a bottom surface of said cap and positioned generally  
53 between said cap and said power supply; and  
54 a switch for selectively controlling said motor, said switch  
55 being depressibly mounted on said protruding portion, said switch  
56 being electrically connected to said motor.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,



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